

Remarks/Arguments:

Claims 1-28 were rejected for being anticipated by Mori et al. (US 6128485). Following the Examiner's lead, the reference hereafter shall be referred to as "Mori". The Applicant does not believe that Mori anticipates the claimed invention because Mori does not actually teach the specific elements required by the claims as originally filed. The Applicant concedes that Mori is concerned with some of the same problems as the Applicant, but does not believe that Mori teaches the claimed invention. While Mori may be concerned with a similar problem and may discuss a very general solution in functional terms, Mori's discussion in the cited passages for the rejection is void of specifics required by the claims and therefore does not anticipate the claimed invention.

A known test for anticipation is: "that which would literally infringe if later in time anticipates if earlier than the date of invention." *Lewmar Marine Inc. v. Barient Inc.*, 827 F.2d 744, 3 U.S.P.Q.2d 1766 (Fed. Cir. 1987). Applicant will show that the language cited in the official action does not, under this test, anticipate the claimed invention. The law clearly requires that the prior-art "must possess the properties expressly recited in the claims". *E.I du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 U.S.P.Q. 2d 1129 (Fed. Cir. 1988). Moreover, "any degree of physical difference, however slight, invalidates claims of anticipation". *Ultradent Products Inc. v. Life-Like Cosmetics Inc.*, 39 U.S.P.Q.2d 1969, 1980 (Utah 1996). In examining the independent claims, it may be seen that the express requirements of the independent claims are not shown in the cited passages and that, under the case law cited above, are therefore not anticipated by the reference.

Specifically, claim 1 as amended (with changes shown) requires:

1. A method in a calling party serving MSC of a telecommunications network for routing a call, comprising:

receiving at the calling party serving MSC call set-up signals for a called party mobile station;

producing the called party number to a home location register;

receiving, from the home location register, a called party serving MSC Id number and a local time for one of the called party serving MSC or the called party;

sending a message number and associated parameters to an IVR to prompt the IVR to play a specified IVR message to the calling party;

receiving an indication from the IVR either that the call is to be set up or that a message should be stored;

setting up the call with the called party serving MSC; and

connecting the call between the calling party and the called party.

~~determining a last known location for the called party mobile station;~~

~~determining whether a “do not disturb” feature is active for the called party mobile station and whether a message should be delivered to a calling party mobile station prior to continuing to process the call and whether the calling party mobile station has responded to the message in a manner indicating that the call should continue to be routed to the called party mobile station.~~

In the claimed invention, the IVR instructs the calling party (originating) MSC to complete the call. As is discussed in the application in relation to Figure 2, the calling party advises the IVR that the call should be completed notwithstanding a “do not disturb” type of

message played by the IVR (see signals 68, 70, 76 and corresponding description of Figure 2).

Based upon the calling party response, the IVR instructs the calling party (serving) MSC, to continue to perform call setup. All of this is triggered by the calling party response. In the cited passage of Mori, however, col. 3, the reference states that the personal station (of the called party) is advised that it is in a prohibited area and that the times in which calls are allowed. All of this is very different from the calling party being told that the called party has selectively activated a do not disturb feature for his present time and location.

The rejection of claim 5 is a perfect example of the Applicants point that the reference is too general to specifically disclose the claimed invention. To wit, claim 5 requires:

5. A method in one of a Home Location Register / Visitors' Location Register, comprising:
 - receiving call set-up signals for a called party mobile station;
 - determining a last known location for the called party mobile station;
 - determining a local time for the last known location for the called party mobile station;

and

producing a local time corresponding to a last known location for the calling party mobile switching center.

The claim, as the Examiner points out in his rejection by paraphrasing the claim, requires operation or a method by an HLR/VLR. The cited passage of Mori is not so specific (col. 4, lines 29-65, col. 5, lines 25-47, col. 8, lines 4-17, 61-67). At best, Mori discusses "means" that block a call and perform other operations during prohibited times. As the Examiner is aware, means plus function language is allowed by 35 U.S.C. 112 so long as the "means" are defined in the specification. In claim interpretation, the definitions of the means then are read into the claims. Thus, a reference to a "means" in the specification is void of meaning and, probably as

a matter of law, cannot specifically anticipate a clear element in a claim. Were it not so, a mere reference to a “communication means” in a patent would forever invalidate all specific future inventions relating to communications devices. Thus, because the claim specifically requires the method steps of claim 5 within an HLR or VLR, the art reference does not anticipate because none of the cited passages disclose an HLR or VLR performing the required steps of claim 5. In particular, Mori does not disclose an HLR or a VLR that is operable to determine a last known location and a local time for the last known location of the called party.

Similarly, claim 9 was rejected though Mori does not teach what the claim requires. To clarify, the cited passages of Mori for the rejection of claim 9 discuss something unrelated to what the claims require. For example, Mori col. 9, lines 22-33 relates to a base station transmitting a “call-incoming” set up signal and a command to display to the personal station of the called party that it is located in a prohibited area. Mori col. 9, lines 56-67 relates to connecting the call between the personal station of the called party and the base station. Mori col. 10, lines 1-9 relates to ordinary and known call authentication.

All of these passages were issued for the first element of claim 9 which is for a method in an HLR and states “receiving at least one of a country code, an area code or a cell phone number from a serving mobile switching center (MSC) for a user equipment terminal in a local time request signal”. As may be seen, the cited passages describe operation unrelated to what the claim requires and certainly do not specifically disclose the required claim elements.

Similarly, claim 17 was rejected through Mori does not specifically disclose required claim elements. The specific claim limitations are for an HLR/VLR and associated structure and corresponding logic. For example, the HLR/VLR are required to include logic for generating a message to an MSC (originating MSC) corresponding to the retrieved time zone data. The first cited passage from Mori of col 3, lines 45-53, relates to the calling party being told (by an unspecified entity (probably a base station) that it is in a prohibited area and that it is receiving a call. This is not the same as the HLR/VLR sending the serving MSC a message that corresponds to retrieved and evaluated time zone data for the called party. The second cited passage of Mori of col. 4, lines 13-22 relates to some service supply means blocking a call and then advising the called party phone that it is in a call prohibited area. This is not the same as what the claims states or requires. The third cited passage of Mori of col. 7, lines 38-54 merely discloses a location database (e.g., an HLR) that tracks the location of the called party. This comes nowhere near being the same as the HLR retrieving time zone data, evaluating the time zone data, and generating a message to the calling party (not the called party or “personal station” of Mori). The fourth cited passage of Mori for this element is col. 12, lines 29-36 which relates to merely determining the location of the called party (“personal station”). This is, again, very different from the required steps of receiving and evaluating time zone data and sending a corresponding message to a serving MSC for the called party.

Regarding claim 23, claim 23 requires:

23. A method in a mobile switching center (MSC), comprising:
 - receiving call set-up signals for a call being established between a calling party and a called party;
 - sending to a home location register one of a location update request signal to determine a serving MSC for the called party and a local time request signal;
 - receiving a local time for one of a last known location for the called party, a country code or an area code;
 - comparing the local time to a do not disturb time range;
 - generating a message number to a message delivery device to prompt the message delivery device to generate a message for the calling party and;
 - playing the message to the calling party.

Applicant respectfully asserts that the cited art does not disclose the claimed invention and that the case should be allowed.

The official action uses principles of inherency to support the position that the claimed elements of claim 23 are anticipated by Mori to compensate for Mori not having a specific teaching for many of the elements of claim 23. Generally, it can be argued that it is inherent of a location database to monitor user locations. Mori does not disclose a user selectable “do not disturb” subscriber feature. Even if Mori did disclose such a subscriber feature, specific operation of such a feature would not be inherent if there are options for such operation. There are many options for operation in a “do not disturb” mode (for example, merely blocking a call). Thus, the Applicant disagrees that these claimed elements in claim 23 are inherent in the teachings of Mori. For one specific example, the claim requires generating a message to a

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message delivery service (e.g., a short message service message server) to prompt the server to generate a corresponding message relating to the do not disturb feature to the calling party. Mori, on the other hand, blocks the call and advises the called party it is in a prohibited area. Thus, the Applicant disagrees that the required claim element is inherent in Mori.

As each of the independent claims are believed to overcome Mori as described above, the applicant does not believe that Mori anticipates the claimed invention and that the independent claims and their corresponding dependent claims are therefore also not anticipated.

Please direct any questions or comments to the undersigned attorney.

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By:

Respectfully submitted,



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